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REMARKS**I. Introduction**

Claims 1-24 are pending in the above application.

Claims 1-24 stand rejected under 35 U.S.C. § 102.

Claims 1, 12, 17, 22 and 25 are independent claims.

II. Prior Art Rejections

A. Claims 1-24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Strauss et al. (U.S. Pat. 5,790,173).

Anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed in a prior art reference as arranged in the claim. See, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986); *Connell v. Sears, Roebuck & Co.*, 220 USPQ 193, 198 (Fed. Cir. 1983).

As explained in Applicant's previous response, Strauss does not disclose or suggest using managing telephone services provided through a HFC network platform having at least a video display device and a telephone device as recited by each of independent claims 1, 12, 17 and 22. Strauss discloses an optical fiber based telephone network which communicates via optical fiber between a host data terminal (HDT) 180 and optical network units (ONU) 210 (Fig. 3: col. 14: 1-6; col. 16: 65 to col. 17: 8). An ONU drops (connects) to a subscriber via both a coaxial cable for video and a twisted pair for telephone (Fig. 4b; col. 14: 7-19; col. 17: 1-8 and 30-35; col. 22: 65 to col. 23: 6). Strauss does not disclose an HFC network platform which has a video display device and a telephone device, i.e. the telephone device in Strauss is merely a twisted pair drop

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from the optical fiber network, and separate connections to the subscriber are required for video and telephone.

In response, the Examiner appears to concede that Strauss itself does not disclose an HFC network platform which has a video display device and a telephone device as discussed above, but the Examiner now alleges that Strauss incorporates by reference U.S. Pat. No. 5,682,325 to Lightfoot et al. which the Examiner alleges provides the deficient disclosure of Strauss. Final Office action, pgs. 2 and 3. The Examiner is mistaken. Particularly, the document incorporated by reference in Strauss is "commonly assigned U.S. patent application Ser. No. 08/374,104 filed on Sept. 12 1994 entitled 'LEVEL 1 GATEWAY FOR VIDEO DIAL TONE NETWORKS'." Strauss, col. 4: 49-52. Whereas U.S. Pat. No. 5,628,325 is based on U.S. App. No. 304,174, not App. No. 374,104 incorporated by Strauss. Lightfoot, cover page, box 21. Further, the title of the Lightfoot patent also does not correspond to the title of the incorporated application in Strauss, i.e. Lightfoot is entitled "LEVEL 1 GATEWAY FOR VIDEO TONE NETWORKS" not "LEVEL 1 GATEWAY FOR VIDEO DIAL TONE NETWORKS."

The only aspects of Lightfoot that even appear to correspond to the incorporation statement are the filing date and the published assignee information, both of which hardly make for a proper incorporation, and clearly would not enable the public to readily locate the incorporated document. See, MPEP 608.01(p) (the intent of the incorporation by reference is to minimize "the public's burden to search for an obtain copies" ... "the referencing application should include an identification of the referenced patent, application"). Accordingly, as neither the application number nor the titles match, the Examiner has not established that the Lightfoot patent is the application which was incorporated by reference, or the incorporation is simply invalid.

Further, even if the Lightfoot patent was intended to be incorporated by reference, *arguendo*, the Examiner is now attempting to combine separate and distinct embodiments of Lightfoot in a manner not contemplated or disclosed by Lightfoot or Strauss. Particularly, the Examiner's theory appears to be that the HFC implementation disclosed in Lightfoot is incorporated into the implementation illustrated by Figure 7 of Strauss. Final Office action, pg. 2. However, Lightfoot discloses three distinct embodiments, Figures 1, 3 and 4. Figure 1 of Lightfoot clearly corresponds to Figure 7 of Strauss, indeed it appears to be essentially the same figure. The HFC implementation of Lightfoot is clearly an alternative embodiment from Figure 1. Lightfoot, col. 4: 9-30. There is no suggestion to merge the HFC system of Lightfoot's Figure 4 with the twisted pair network (ADSL) illustrated in Figure 1 of Lightfoot, as the Examiner now attempts to do in the rejection which merges Lightfoot's implementation in Figure 4 with Strauss' implementation in Strauss Figure 7 (Lightfoot Figure 1). A mere incorporation does not give license to pick and choose features of the incorporated material and use them in a way not disclosed by the incorporated reference.

Finally, the attempted reliance on the alleged incorporation attempts to alter the expressed disclosure of Strauss. Strauss is explicitly clear that "the final drop into the subscriber's home is over telephone lines." Strauss, col. 4: 54-56. The doctrine of "incorporation by reference" merely enables an application to omit material from their own disclosure, e.g. to prevent the applicant's disclosure from being excessively long. The doctrine includes "essential materials" which are necessary to describe the claimed invention, provide an enabling disclosure, or provide a best mode; and non-essential materials to indicate the background of the invention or state of the art. MPEP 608.01(p). The doctrine does not include modifying actual disclosed subject matter, e.g. to make the applicant's disclosed invention

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operate in a different way than disclosed. The Examiner's attempted use of the alleged incorporation is clearly a modification of the expressed disclosure of Strauss – something which is clearly not provided for by a mere incorporation of another reference.

Accordingly, as Strauss does not disclose each and every limitation of independent claims 1, 12, 17 or 22, Straus does not anticipate claims 1, 12, 17 or 22, nor claims 2-11, 13-16, 18-21 and 23-24 which depend on claims 1, 12, 17 and 22, respectively.

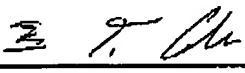
III. Conclusion

Having fully responded to the Office action, the application is believed to be in condition for allowance. Should any issues arise that prevent early allowance of the above application, the examiner is invited contact the undersigned to resolve such issues.

To the extent an extension of time is needed for consideration of this response, Applicant hereby request such extension and, the Commissioner is hereby authorized to charge deposit account number 502117 for any fees associated therewith.

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Respectfully submitted,

By: 
Lawrence T. Cullen
Reg. No.: 44,489

Motorola Connected Home Solutions
101 Tournament Drive
Horsham, PA 19044
(215) 323-1797